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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,874	10/30/2001	James Alun Wynne Morgan	13384-002001	1385

7590

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EXAMINER

PARAS JR, PETER

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 04/23/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/889,874

Applicant(s)

MORGAN ET AL.

Examiner

Peter Paras, Jr.

Art Unit

1632

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-5 and 17-28 is/are objected to.
- 8) ☒ Claim(s) 6-16 and 29-30 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

Claims 1-5 appear to be improper process claims, which cannot be defined under 35 U.S.C. 101. Furthermore, since the claims are directed to use of a product it is unclear whether the product or the method is the claimed invention. Accordingly, the claims are withdrawn from consideration in the instant restriction requirement.

Claims 17-28 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to the claims it depends from in the alternative. See MPEP § 608.01(n). Accordingly, the claims 17-28 have not been further treated on the merits and are not included in the instant restriction requirement.

Since claims 1-5 and 17-28 have been withdrawn from consideration in the instant restriction requirement for the reasons stated above, such claims if amended will be treated as newly presented claims with respect to the originally presented inventions.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 6-10, drawn to a composition for the control of parasitic nematodes, which comprises an agent, wherein the agent is a bacterium that is a symbiont of an entomopathogenic nematode.

Group II, claim(s) 6, drawn to a composition for the control of parasitic nematodes, which comprises an agent, wherein the agent is an engineered bacterium.

Art Unit: 1632

Group III, claim(s) 6 and 11, drawn to a composition for the control of parasitic nematodes, which comprises an agent, wherein the agent is a peptide.

Group IV, claim(s) 12-16 and 29, drawn to a nucleic acid encoding a peptide that is a nematode control agent and a method of producing a nematode control agent comprising expressing the same nucleic acid.

Group V, claim(s) 30, drawn to an antibody or fragment thereof that binds a peptide that is a nematode control agent.

PCT Rule 13.2 requires that unity of invention exists only when there is a shared same or corresponding technical feature among the claimed inventions. All the groupings are directed to products that have different special technical features that are not shared by the remaining groups. Group I is directed to a composition, which has a special technical feature of a bacterium that is a symbiont of an entomopathogenic nematode, which is not shared by any of the remaining groups. Group II is directed to a composition, which has a special technical feature of an engineered bacterium, which is not shared by any of the remaining groups. Group III is directed to a composition, which has a special technical feature of a peptide, which is not shared by any of the remaining groups. Group IV is directed to a nucleic acid, which is the special technical feature, which is not shared by any of the remaining groups. Group V is directed an antibody, which is the special technical feature, which is not shared by any of the remaining groups.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at 703-305-4051. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703) 308-4242 and (703) 305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Dianiece Jacobs whose telephone number is (703) 305-3388.

Peter Paras, Jr.

Art Unit 1632

**PETER PARAS**  
**PATENT EXAMINER**

